DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/05/2011 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicants have amended the independent claims to require the step of selecting either a semi-finished or an unfinished lens blank to use in the operation based on the required shaping of the lens.

4. The arguments presented are focused on these new limitations and how the Kennedy fails to teach this concept.

5. A new ground of rejection is presented below with this new limitation taken into consideration.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, USP 5,425,665 in view of Siders et al, US Patent Publication 2003/0181133.

9. Regarding claim 1, Kennedy teaches a method and apparatus for manufacturing a spectacle lens (see title) sets based on order information (see figure 8 and column 1 lines 21-44) comprising a lens forming step of forming a circular plastic material (see column 1 describing attaching lens material to block) where the block aides in forming the shape of the lens by positing it to be processed in the desired shape (see summary of invention, column 2), wherein the lens member is a lens blank (item 44, figure 2 and column 4 line 30) and that the forming step comprising using the order information to first set the geometric center, then to calculate the position of the optical center based off of provided information such as pupil distance, frame distance, distance between lenses, and other provided measurements (column 6 line 42 – column 8 line 4, and figures 8 and 9). The method of Kennedy demonstrates the known method of setting a

lens blank by its geometric center and then forming the optical center from that point utilizing provided measurements to form both lenses in a special frame.

10. The method of Kennedy demonstrates the known method of setting a lens blank by its geometric center and then forming the optical center from that point utilizing provided measurements to form both lenses in a special frame. It is implicitly taught that the steps of centering the geometric center take the geometric center of the edge shape into consideration during this step. The teachings of setting the geometric center of the lens blank first (and the further descriptions on how block the settings and form the lens) provides an understanding of the importance of centering the lens blank. This would implicitly include centering it under all considerations (both with frame center and the edge shape) so that it is true positing based on the geometric center considerations as a whole to provide the listed advantages of Kennedy.

11. Additionally, one of ordinary skill in the art at the time of the invention would have found it obvious to set the geometric center of the lens member in direct relation to both the geometric center of the lens sub frame and the lends edge shape so that the lens member would be centered from all positions so the formation steps are preformed more efficiently.

12. Kennedy fails to disclose a step of selecting a lens blank from a selection of semi-finished or unfinished lens blanks in order to expedite the production time due to known frequency of product sales.

13. In the same field of endeavor of providing a system and method for producing ophthalmic lenses, Siders teaches there are two methods of making finished lenses,

from a group of semi-finished or unfinished lens group that is selected to most easily complete the prescribed order (see abstract, [0081], [0091], and [0124]). The explicit teachings of selecting a blank based of order information compared to a large selection of lens blanks (both semi-finished and unfinished) is an explicit teaching of a known business method of stocking the right starting materials in order to save time, effort, and material costs by utilizing a starting lens that needs the least amount of work during the operation.

14. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to select either a semi-finished or unfinished lens blank to start the processed based on the order information (and have these different lens blanks stocked by frequency of use) as taught by Siders in the Kennedy method for the known benefit of saving time, money, materials, and effort by selecting the appropriate starting material to make the shaping and forming steps simpler and more efficient.

15. Regarding claim 3, Kennedy further teaches that a computer is utilized to control the positing of the block and blank so that the angle, distance in X direction, and distance in the Y direction is automatically controlled to block out the lens during rotation and formation (columns 7 and 8).

16. Claims 2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, USP 5,425,665 in view of Siders et al, US Patent Publication 2003/0181133, and in further view of Miyazawa et al, US Patent Publication 2002/0160690.

17. Regarding claims 2 and 4, Kennedy implicitly teaches that the blank utilized has a smallest diameter that is at least as big as the maximum distance of the order is performed by the QC check at the bottom of column 7. The ordinary artisan practicing the Kennedy process would have found it obvious to have the blank had to be at least as big as the order in order for the product to be produced

18. Kennedy remains as applied in claim 1 above, but is silent on the limitations of selecting a blank from a pool of blanks that are prepared in advance. Siders is applied as shown above, and further teaches that it is known to select a semi-finished (or unfinished) lens blank to be utilized in the method of making the lens from a selection of starting blanks depending on the order information [0081-0088 and 0124], but is silent on the specific dimensions and ratios of the different measurements.

19. In the same field of endeavor of forming spectacle lenses through controlling the optical center of the final product, Miyazawa is utilized for the sole purpose to show that it is known in the art at the time of the invention to provide a selection of lens blanks made in advance to be selected for the formation steps of the actual lens.

20. Miyazawa teaches that the lens member forming step uses a lens blank (semi-finished lens, [0044]) of which both the surface have not yet processed to the curved surface shape satisfying the optical specification of the spectacle lens related to the order [0044] but processed to a predetermined surface shape as the plastic material of a processing target, and is able to process the spectacle lens related to the order appropriately out of a plurality of lens blanks manufactured and prepared in advance [0044-0045], and wherein the lens blank having an outside diameter at least larger than

a maximum distance between a frame center and a frame of the spectacle frame related to the order and having the smallest outside diameter as well ("the semi-finished lens, therefore has a thickness relatively larger than a finish thickness" [0044]) is selected and processed so that the spectacle lens related to the order is manufactured (optimum semi-finished lens to be machined is selected from the stock [0045]).

21. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize Miyazawa's process of making blanks in advance to be readily utilized by the main process in the Kennedy method for the benefit of having a blank with all known values already prepared prior to lens shaping. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Int'l Co V. Teleflex Inc, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

22. Regarding claim 5, Kennedy further teaches that a computer is utilized to control the positing of the block and blank so that the angle, distance in X direction, and distance in the Y direction is automatically controlled to block out the lens during rotation and formation (columns 7 and 8).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB T. MINSKEY whose telephone number is (571)270-7003. The examiner can normally be reached on Monday to Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Daniels can be reached on 571-272-2450. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTM

/Matthew J. Daniels/
Supervisory Patent Examiner, Art Unit 1741